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In the Supreme Court of the United States

OCTOBER TERM, 1979

SIDNEY A. DIAMOND, COMMISSIONER OF PATENTS AND TRADEMARKS, PETITIONER

v.

JOHN J. BRADLEY AND BENJAMIN S. FRANKLIN

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF CUSTOMS AND PATENT APPEALS

REPLY MEMORANDUM FOR THE PETITIONER

WADE H. MCCREE, JR.
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Washington, D.C. 20530

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Respondents contend, as they did below (see Pet. 8 n. 12), that they have created a novel arrangement of computer hardware (Br. in Opp. 14-15, 19); they argue that *Parker* v. *Flook*, 437 U.S. 584 (1978), is distinguishable since the process in *Flook*, aside from the mathematical algorithm, was admittedly old (Br. in Opp. 15-16).

The premise of this argument simply renews respondents' disagreement with the Board of Appeals' findings, which the CCPA declined to disturb. Although respondents characterize their claim as a novel machine comprised of an arrangement of hardware including a firmware element, what matters is whether that description masks a claim to a machine that is old in the art, whose only novelty is an unpatentable algorithm

embodied in the firmware (Pet. 9-10).[1] The Board, affirming the examiner on this point, found that "save for the microprogramming," Bradley's arrangement of hardware was old in the art (Pet. App. 26a-27a; see Pet. 8). The CCPA, while noting respondents' challenge to this determination, left standing the Board's finding on this factual issue (Pet. App. 13a). Given the prior art as set out in the Patent Office record, the court could hardly have done otherwise. Respondents incorporated by reference in their application an earlier application by Claude Carre and others that discloses an arrangement of hardware identical to the arrangement claimed in respondents' application (Pet. App. 43a-44a, 52a-53a). Respondents now concede as much (compare Br. in Opp. 12 n.22 with Pet. 8-9 n.12).[2]

The program in firmware is thus the only novel aspect of respondents' invention. As we have shown (Pet. 11-12), however, that program is not itself patentable, and respondents accordingly do not have a patentable invention under the analysis required by *Parker* v. *Flook*, *supra*, 437 U.S. at 594-596. Respondents contend (Br. in Opp. 11, 17) that petitioner's interpretation of *Flook* is incorrect, and that the CCPA here and in other cases has correctly followed this Court's teaching in that

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[1]Thus respondents' assertion that it is conceded that their claimed invention "is a machine" (Br. in Opp. 3, 19) is beside the point.

[2]Moreover, in their application respondents noted that their invention could be practiced with "computer processors including microprogrammed control units" disclosed in specified issued patents (R. 126). This language strongly suggests that respondents recognized in their application that their inventive contribution was in the additional matter not contained in the Carre application—the microprogram—and not in the hardware with which it was implemented.

case (Br. in Opp. 17-18 & nn.30, 31). That is the issue presented in this case and in *Diamond* v. *Diehr*, No. 79-1112, and it is that question that merits review by this Court.

For the reasons stated herein and in the petition, the petition for a writ of certiorari should be granted.

Respectfully submitted.

WADE H. MCCREE, JR.
Solicitor General

FEBRUARY 1980